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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,679

10/18/2006

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EXAMINER

SHAFFER, RICKY D

ART UNIT

PAPER NUMBER

2872

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DELIVERY MODE

08/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/567,679	Applicant(s) SEYFRIED, VOLKER	
	Examiner Ricky D. Shafer	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 2-9, 13-20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10-12, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/09/06 & 10/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of Group III (claims 9-14 and 21-23) and species "B", depicted by Fig. 3, in the reply filed on 5/22/2009 is acknowledged.

Please be advised that the grouping of claims (claims 9-14 and 20-23) associated with Group III in the Office action mailed on 3/25/2009 includes a minor typographical error. The correct grouping of claims for Group III should be claims 9-14 and 21-23.

In addition, applicant should note that claim 23 has been withdrawn from further consideration as being drawn to a nonelected species, species "C", due to the fact that claim 23 depends from claim 13.

2. Claims 2-9, 13-20 and 23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/22/2009.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, line 2, the use of the language "and/or" is vague and indefinite due to the fact that claim language must be expressed in the alternative only.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Aksyuk et al ('946).

To the extent the claims are definite, Aksyuk et al discloses an optical device comprising a dispersive element (12) operatively arranged to split a first light beam (via port 16) from a first direction into various wavelengths (see column 2, lines 31-38); an imaging optic (20) and a microstructured element (14, 30) operatively arranged at a cleavage plane (see Fig. 1), wherein said cleavage plane is defined by said dispersive element and said imaging optic, said cleavage plane defining a position for said various wavelengths (see column 2, lines 42-55), wherein said microstructured element is capable of being operatively arranged to deflect said first light beam from said first direction and at least a second light beam from a second direction (see Fig. 1), said light beams focused via said imaging optic on positions corresponding to their respective wavelength (see column 2, lines 38-41) and to said dispersive element (see Fig. 1), wherein said dispersive element is operatively arranged to collinearly unite said light beams (see column 2, line 63 to column 3, line 1), wherein the microstructured element comprises mirrored surfaces of different inclinations (see column 3, lines 27-30), wherein the microstructured element comprises a micromirror array or micro-electromechanical mirror (see column 3, line 12-39).

Note figures 1 and 2 along with the associated description thereof.

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7. Claims 1, 10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Peng et al ('628).

To the extent the claims are definite, Peng et al discloses an optical device comprising a dispersive element (12) operatively arranged to split a first light beam (via element 11) from a first direction into various wavelengths (3-1, 3-3, 3-5); an imaging optic (13) and a microstructured element (18) operatively arranged at a cleavage plane (see figures 2A and 2B), wherein said cleavage plane is defined by said dispersive element and said imaging optic, said cleavage plane defining a position for said various wavelengths (see figures 2A and 2B), wherein said microstructured element is capable of being operatively arranged to deflect said first light beam from said first direction and at least a second light beam from a second direction (see figures 2A and 2B), said light beams focused via said imaging optic on positions corresponding to their respective wavelength and to said dispersive element (see figures 2A and 2B), wherein said dispersive element is operatively arranged to collinearly unite said light beams (see column 5, lines 35-37), wherein the microstructured element comprises mirrored surfaces of different inclinations (see column 4, lines 46-48 along with Fig. 2B), wherein the microstructured element comprises a micromirror array (see column 6, lines 1-4). Note figures 2A and 2B along with the associated description thereof.

8. Claims 1, 10-12, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Yokoi ('484).

To the extent the claims are definite, Yokoi discloses a microscope comprising an optical device comprising a dispersive element (44) operatively arranged to split a first light beam (via elements 31 and 32) from a first direction into various wavelengths (see column 21, lines 13-30);

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an imaging optic (43) and a microstructured element (42) operatively arranged at a cleavage plane (see Fig. 10), wherein said cleavage plane is defined by said dispersive element and said imaging optic, said cleavage plane defining a position for said various wavelengths (see column 13-23), wherein said microstructured element is capable of being operatively arranged to deflect said first light beam from said first direction and at least a second light beam from a second direction (see Fig. 10), said light beams focused via said imaging optic on positions corresponding to their respective wavelength and to said dispersive element (see Fig. 10), wherein said dispersive element is operatively arranged to collinearly unite said light beams (see Fig. 10), wherein the microstructured element comprises mirrored surfaces of different inclinations (see column 22, lines 35-41), wherein the microstructured element comprises a micromirror (see column 21, lines 19-23) or micro-electromechanical mirror (see column 22, lines 35-41). Note, by example only, Fig. 10 along with the associated description thereof.

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference numerals (32, 34, 36, 38, 40 and 42), (46, 48, 50, 52, 54 and 56) and (62 and 64), disclosed in paragraphs 0030-0032 of the specification, respectively, have not been properly illustrated and/or labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

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informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320.

The examiner can normally be reached on Mon-Fri. 11:00 to 7:30.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RDS

July 31, 2009

/Ricky D. Shafer/
Primary Examiner
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